UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/445,085	12/02/1999	KATSUTOSHI SAKAO	SONYJP3.3-0	9445

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EXAMINER
ARMSTRONG, ANGELA A

ART UNIT	PAPER NUMBER
2654	

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

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SAKAO ET AL.</td></tr>
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>21 January 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>50-66</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>50-66</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)   4) ☐ Interview Summary (PTO-413)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   Paper No(s)/Mail Date. _____ .
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)   5) ☐ Notice of Informal Patent Application (PTO-152)
   Paper No(s)/Mail Date _____ .   6) ☐ Other: _____ .

DETAILED ACTION

Response to Arguments

1.   In view of the Appeal Brief filed on January 21, 2005, PROSECUTION IS HEREBY

REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following

two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37

CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a

supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or

other evidence are permitted.   See 37 CFR 1.193(b)(2)

Applicant argues that a person having ordinary skill in the art of integrated receiver

decoders would not normally consider the teachings of Logan. The Examiner disagrees and

argues Logan specifically teaches other information storage, processing and communications

schemes can be used in the system, including cable modem and satellite links (col. 7, lines 41-

66). Further, in response to applicant's arguments against the references individually, one cannot

show nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re*

Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Townsend was cited for teaching

the specifics of the other possible information storage, processing and communications schemes

to include an integrated receiver decoder (IRD) or a MPEG audio decoder.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 50-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al

(US Patent No. 6,199,076) in view of deCarmo (US Patent No. 5,838,996) and further in view of

Townsend et al (US Patent Application No. 2002/0042918).

3.   Regarding claim 50, Logan teaches a receiver for receiving compressed digital data as

converting received digital signals to analog for use with a speaker (col. 4, lines 55-59) and

storing the received data on a replaceable media (col. 7, lines 63-66)

Additionally, Logan teaches a decoder for decoding the received compressed digital data

to provide decoded digital data as a stereo codec at col. 4, lines 55-56

Additionally, Logan teaches compressed data of a plurality of contents at col. 5, lines 55-

col. 6, lines 5 in which Logan teaches that the compressed data consists of audio programs,

announcements, text, image, advertising segments and program catalog information and col. 44,

lines 5-48 in which Logan teaches of Audio Programming with HTML which allows for

interactively browsing audio programs with synchronized images, conversion of HTML to

synthetic speech, and viewing and printing of narrative text.

Logan teaches a first output terminal for providing the compressed digital data to an

external device through a bi-directional data communication line at col. 4, line 46-50.

Logan teaches a second output terminal for providing the decoded digital data to the

external device through a one-way data communication line at col. 7, lines 63-66.

Logan does not specifically teach a controller that determines which type of data to

provide to an external device as a function of a connection state with the external device.

However, selectively providing data type to a device as a function of the device capabilities was

well known in the art.

In a similar field of endeavor, deCarmo teaches a system for determining presence of

hardware decompression and selectively enabling hardware-based and software-based

decompression, which can dynamically choose between hardware and software

compression/decompression so as to maximize the usage of an digital signal device hardware

capabilities (Abstract, Figures 2-4).

Therefore, it would have been obvious to one of ordinary skill at the time of the invention

to modify the system of Logan to implement a controller for controlling the type of data output

to external devices, as provided by deCarmo, for the purpose of ensuring that the transmitted

data can be fully utilized at the receiver by maximizing the usage of an digital signal device

hardware capabilities.

Logan teaches other information storage, processing and communications schemes can be used in the system, including cable modem and satellite links (col. 7, lines 41-66).

Logan does not teach the specifics of the other possible information storage, processing and communications schemes to include an integrated receiver decoder (IRD) or a MPEG audio decoder.

Townsend teaches a receiver for receiving video signals comprising video data and information data which provides for a digital integrated receiver decoder to receive signals from a satellite, a video recorder, a personal computer, descrambling of signals that are input to a video decompression and processing circuit and an audio decompression and processing circuit, and MPEG decoding (paragraphs 0035 and 0037-0039).

It would have been obvious to one of ordinary skill at the time of the invention to modify the system of Logan to implement other possible information storage, processing and communications schemes to include an integrated receiver decoder (IRD) or a MPEG audio decoder, for the purpose of providing the user the capabilities to access and store a plurality of data formats in a plurality of environments.

Regarding claim 51, Logan teaches converting the received digital signals to analog for use with a speaker (col. 4, lines 55-59).

Regarding claim 52, receiving compressed digital data and additional information at col. 5, lines 55-col. 6, lines 5, wherein the additional information includes images (col. 6, lines 1-3; col. 5, lines 55-59), character information (col. 4, lines 46-50, col. 5, line 55 – col. 6, line 5), compressed tunes (col. 5, lines 55-63) and the audio data and additional information are distributed through digital broadcast (col. 40, lines 18-21).

Regarding claims 59-62, Logan teaches other information storage, processing and communications schemes can be used in the system, including cable modem and satellite links (col. 7, lines 41-66).

Logan does not teach the specifics of the other possible information storage, processing and communications schemes to include an integrated receiver decoder (IRD) or a MPEG audio decoder.

Townsend teaches a receiver for receiving video signals comprising video data and information data which provides for a digital integrated receiver decoder to receive signals from a satellite, a video recorder, a personal computer, descrambling of signals that are input to a video decompression and processing circuit and an audio decompression and processing circuit, and MPEG decoding (paragraphs 0035 and 0037-0039).

It would have been obvious to one of ordinary skill at the time of the invention to modify the system of Logan to implement other possible information storage, processing and communications schemes to include an integrated receiver decoder (IRD) or a MPEG audio decoder, for the purpose of providing the user the capabilities to access and store a plurality of data formats in a plurality of environments.

Regarding claims 54-56, 58, and 63-66, claims 54-56, 58, and 63-66 are similar in scope and content to claims 50-52 and 59-62, and are therefore rejected under similar rationale.

4.   Claims 53 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan

et al (US Patent No. 6,199,076) in view of deCarmo (US Patent No. 5,838,996) and Townsend et

al (US Patent Application No. 2002/0042918), as applied to claims 50 and 54 above, and in

further view of well known prior art.

5.   Regarding claims 53 and 57, Logan Townsend, and deCarmo teach everything as claimed

in claims 50 and 54. The combination does not specifically teach that the controller carries out

control so that a connection for providing the received compressed digital data to an external

device is preferentially selected. However, preferentially providing compressed data to an

external device was well known in the art as a mechanism for reducing data storage

requirements.

        Therefore, it would have been obvious to one of ordinary skill at the time of the invention

to preferentially provide compressed data to an external device in the audio distribution system

of Logan, for the purpose of reducing data storage requirements, as was well known in the art.

        Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Angela A Armstrong whose telephone number is 571-272-7598.

The examiner can normally be reached on Monday-Thursday 11:00-8:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Richemond Dorvil can be reached on 571-272-7602. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Angela A Armstrong
Examiner
Art Unit 2654

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AAA
April 1, 2005